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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,393	04/10/2001	Michael E. McHenry	608-281	8969

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EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,393

Applicant(s)

MCHENRY ET AL.

Examiner

Nicholas D. Rosen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-32 is/are allowed.
- 6) ☒ Claim(s) 33 is/are rejected.
- 7) ☒ Claim(s) 1-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-33 have been examined.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it is substantially longer than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 1-22 and 33 are objected to because of the following informalities: Claim 1 refers to an "engine oil having user desired credentials," which does not appear to be proper usage of the word "credentials". Examiner suggests replacing "credentials" by "characteristics". Appropriate correction is required.

Claims 8-14 are objected to because of the following informalities: In each of claims 8-12, reference is made to "the final customized motor oil," which does not quite

have proper antecedent basis, because claim 1 uses the term "engine oil". Consistency between "motor" and "engine" is desirable. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 33 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leonard et al. (U.S. Patent 3,826,904). Leonard discloses blending a custom motor oil (Abstract; column 1; column 2, lines 23-25; etc.). A custom motor oil made by practicing the method of any one of claims 4 and 15-32 would not, in general, be physically distinguishable from a custom motor oil made by other methods, as disclosed by Leonard, or from a motor oil purchased off the shelf at a store selling automotive supplies. Therefore, the product-by-process claim 33 is held to be unpatentable. See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); *In re Fessman*, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974); and *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Allowable Subject Matter

Claims 1-22 are objected to, but are believed to be potentially allowable upon correction of minor informalities.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Finkelstein ("High Mileage: Old Engines May Need Lots of Work"), using data identifying a motor vehicle to determine a recommended vehicle engine oil, which would presumably be provided by some seller (as per step (c)). However, Finkelstein does not disclose inputting the data, and analyzing the data by computer; and while it is general well known to analyze data by computer, there is no occasion to do in the situation disclosed by Finkelstein.

Claims 23-32 are allowed.

The following is an examiner's statement of reasons for allowance: The closest prior art of record, Leonard et al. (U.S. Patent 3,826,904), discloses a method of obtaining custom lubricating oil by (b) blending a custom engine oil using information supplied by a customer, using (as per (a)) information about the customer's desired operational characteristics (Abstract; column 1; especially column 2, lines 23-25). Leonard does not expressly disclose (c) delivering to, installing, or making available for pickup by the user from (a) the custom engine oil from (b), but this is held to be inherent, as blending a custom engine oil according to a user's specifications would be pointless if the custom engine oil were not delivered to, installed, or made available for pickup by the user. Leonard does not disclose using an implement to transmit information about a user's motor vehicle type, environment of use, and desired

operational characteristics, to a customized blending facility, but it is well known to use implements (e.g., networked computers, telephones, Post Office trucks, etc.) to transmit information. Leonard does not disclose transmitting information about a user's motor vehicle type, but Finkelstein teaches a manual for a motor vehicle type containing a recommendation on suitable engine oil (paragraph beginning "A: Most owner's manuals"). Leonard does not disclose transmitting information about a user's environment of use, nor does any other prior art of record. It would be surprising if no one had ever provided information about environment of use, for the purpose of having a suitable engine oil recommended, but even supposing this to be the case, Finkelstein is concerned with looking up the shop manual for an existing vehicle to learn what existing lubricant is recommended, rather than blending a custom engine oil, making the combination with Leonard questionable; and any comparable prior art for providing information about environment of use to obtain a recommendation of an existing engine oil would be expected to raise the same issues.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schieman (U.S. Patent 3,873,455) discloses a five-grade motor

oil for internal combustion engines. Schwartz et al. (U.S. Patent 4,847,768) discloses an automatic engine oil change indication system. O'Rear et al. (U.S. Patent 6,562,230) disclose synthesis of narrow lube cuts from Fischer-Tropsch products. Bartholomew et al. (U.S. Patent Application Publication 2001/0047309) disclose a nail polish color selection system and method (and note that their method is also applicable to custom lubricants, in paragraph [0070]). Alexander (U.S. Patent Application Publication 2001/0049343) discloses a functional fluid.

O'Hara et al. ("Equipment Protection through Customized Oil Analysis") disclose analyzing used oil to monitor equipment (Abstract only). Finkelstein ("High Mileage: Old Engines May Need Lots of Work") discloses a shop manual containing a recommendation for lubricants for a particular motor vehicle.

Strasser et al. (WO 96/36924 A1) disclose a remote control dispensing system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. (Wynn Coggins is currently on assignment elsewhere in the Patent Office; the examiner's acting supervisor, Jeffrey Smith, can be reached at 703-308-3588.) The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER

June 9, 2004